

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

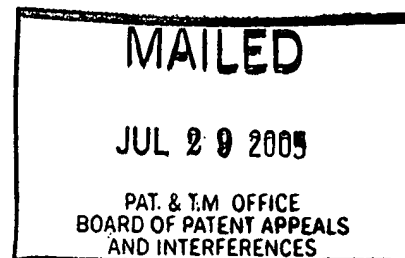
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNHARD GOTZ

Appeal No. 2005-1811
Application 09/421,676

ON BRIEF



Before FRANKFORT, McQUADE, and BAHR, **Administrative Patent Judges.**

FRANKFORT, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19, 21 and 22, all of the claims remaining in the application. Claim 20 has been canceled.

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As noted on page 1 of the specification, appellant's invention relates generally to an industrial truck and, more particularly, to a fork lift truck having a rear weight, and an internal combustion engine. The objective of appellant's invention is to provide an industrial truck wherein the internal combustion engine (4) is mounted to and carried by the rear weight (1) of the truck so that vibrations of the engine are transmitted from the engine to the rear weight and from the rear weight to the frame of the truck. Independent claims 1, 21 and 22 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix A of appellant's brief.

The prior art references of record relied upon by the examiner are:

Wilkes, Jr. et al. (Wilkes)	4,202,453	May 13, 1980
Wakana et al (Wakana)	6,085,858	Jul. 11, 2000

Claims 1 through 19, 21 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 7, 21 and 22 stand rejected under 35 U.S.C.
§ 102(b) as being anticipated by Wilkes.

Claims 2 through 6 and 8 through 19 stand rejected under
35 U.S.C. § 103(a) as being unpatentable over Wilkes in view of
Wakana.¹

Rather than reiterate the conflicting viewpoints advanced by
appellant and the examiner regarding the above-noted rejections,
we refer to the final rejection (mailed October 28, 2002), the
examiner's answer (mailed December 12, 2003 and the supplemental
examiner's answer (mailed July 23, 2004) for an exposition of the
examiner's position, and to appellant's supplemental brief (filed
November 5, 2003) and supplemental reply brief (filed September
27, 2004) for the arguments thereagainst.

¹ As noted on page 2 of the examiner's answer, the rejection of
claim 21 under obviousness-type double patenting has been
withdrawn in light of a terminal disclaimer filed November 5,
2003.

OPINION

Having carefully reviewed the indefiniteness, anticipation and obviousness issues raised in this appeal in light of the record before us, we have made the determinations which follow.

In rejecting claims 1 through 19, 21 and 22 under 35 U.S.C. § 112, second paragraph, the examiner urges that the recitation regarding the rear weight being "separate from the frame and connected to the frame" in independent claims 1, 21 and 22 renders those claims, and the claims which depend therefrom, unclear and indefinite, since "the statement itself is contradictory" (final rejection, page 3) because an element can not be separate from a frame and connected to the same. We do not agree.

When the language in question is given its broadest reasonable interpretation consistent with the specification, we understand the above recitation to merely mean that the rear weight is "separate from the frame" in the sense that it is a distinct or separate element from the frame which is formed separately and then mounted on or connected to the frame. Note pages 6-7 of appellant's supplemental brief and see page 2, lines

2-16, and the paragraph bridging pages 3-4, of the present specification wherein this aspect of the invention is clearly and unambiguously set forth. Since we find that the claims on appeal do particularly point out and distinctly claim that which applicant regards as his invention, and that one of ordinary skill in the art would have been reasonably apprised of the metes and bounds of the claimed subject matter, we will not sustain the examiner's rejection under 35 U.S.C. § 112, second paragraph.

Concerning the rejection of claims 1, 7, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Wilkes, we agree with the examiner that Wilkes discloses an industrial truck (Figs. 1-4) comprising a frame or utility unit (14) on which a heavy-duty crane (52) and an operator's compartment (127) are mounted, a rear weight or power unit (12) separate from the frame/utility unit (14) and connected to the frame/utility unit via an articulated joint (16), and an internal combustion engine (38) mounted on and fastened to the rear weight/power unit (12) such that the engine is carried on the industrial truck by the rear weight/power unit (12), and such that the rear weight/power unit is positioned between the engine (38) and the frame/utility unit (14) and such that vibrations from the engine are transmitted from the engine to the rear weight/power unit (12)

and from the rear weight/power unit to the frame/utility unit (14). Wilkes also discloses a hydraulic unit (Fig. 7 and col. 3, lines 63-67) fastened to the internal combustion engine such that the hydraulic unit and engine are mounted directly on the rear weight/power unit (12).

Contrary to appellant's arguments in the supplemental brief, we consider that the broad language "rear weight" as used in claims 1, 7, 21 and 22 on appeal is clearly readable on the power unit (12) of Wilkes, since that unit is separate from and connected to the frame/utility unit (14) and acts as a counterbalance or counterweight ("rear weight") during operation of the crane (52). See, e.g., column 1, lines 11-15, column 5, lines 39-43 and column 7, line 63 through column 8, line 2, of Wilkes. Appellant's assertion that the term "rear weight" or counterweight must be understood to be a component separate from the vehicle frame and made out of high internal damping material, such a gray cast iron, like the counterweight of a fork lift truck, is much more specific than the broad language used in the claims on appeal, and is belied by the very description we have

pointed to above in Wilkes which makes clear that the power unit (12) acts as a rear weight or counterweight during operation the crane (52) which is mounted to the separate frame/utility unit (14).

Thus, since we find appellant's argument in the briefs concerning claims 1, 7, 21 and 22 to be unpersuasive, and since we agree with the examiner that the industrial truck broadly defined in those claims is readable on the industrial truck of Wilkes, we will sustain the examiner's rejection of claims 1, 7, 21 and 22 under 35 U.S.C. § 102(b).

Regarding the examiner's rejection of dependent claims 2 through 6 and 8 through 19 under 35 U.S.C. § 103(a) based on the collective teachings of Wilkes and Wakana, we note that appellant has not specifically challenged the examiner's proposed combination of these references, but instead still maintains the view that the examiner has ignored the conventional and accepted meaning of the term "rear weight" in the industrial truck art and improperly equated the wheeled power unit (12) of Wilkes having an engine (38) mounted thereon to the claimed structure. For the reasons already set forth above in our discussion of the

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anticipation rejection, we again find this line of argument to be unpersuasive. Moreover, we are in full agreement with the examiner's position as set forth in the answer (pages 4-5) and supplemental answer concerning the collective teachings of the applied patents to Wilkes and Wakana, and find that the combination as posited by the examiner would have been obvious to one of ordinary skill in the art at the time of appellant's invention and that the combination would have resulted in the subject matter set forth in claims 2 through 6 and 8 through 19 on appeal. Thus, the examiner's rejection of claims 2 through 6 and 8 through 19 under 35 U.S.C. § 103(a) is sustained.

In accordance with the foregoing, the decision of the examiner rejecting claims 1 through 19, 21 and 22 of the present application under 35 U.S.C. § 112, second paragraph, is reversed, while the rejections of claims 1, 7, 21 and 22 under 35 U.S.C. § 102(b) and of claims 2 through 6 and 8 through 19 under 35 U.S.C. § 103(a) are sustained. Since at least one rejection of each of the claims on appeal has been sustained, it follows that the decision of the examiner rejecting claims 1 through 19, 21 and 22 of the present application is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)

John P. McQuade

JOHN P. McQUADE)
Administrative Patent Judge)

Jennifer D. Bahr

JENNIFER D. BAHR)
Administrative Patent Judge)

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